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Group Art Unit 1791

REMARKS

Applicants have considered the outstanding official action. It is respectfully submitted that the claims are directed to patentable subject matter as set forth below.

Applicants confirm the election of the claims of Group I, i.e., claims 44-64, drawn to a method of embossing a web. Applicants reserve the right to file divisional application(s) on the non-elected subject matter of Group II, i.e., claims 65-74, drawn to a device for embossing a web; and Group III, i.e., claims 75-90, drawn to a laminate.

Claim 56 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite based on it being unclear whether the protuberances form the previously mentioned background embossing. Applicants have amended claim 56 to clarify that the third series of protuberances form a background pattern. Claim 56 is submitted to be definite. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §112.

The sole rejection based on art is of claims 44-64 under 35 U.S.C. §103(a) as being obvious over WO 99/44814 (Biagiotti) in view of U.S. Patent No. 5,339,730 (Ruppel).

Applicants respectfully submit that the applied art does not teach or suggest the claimed method.

Initially, it is noted that sole pending independent claim 44 has been amended to further define the claimed method to clarify the distinctions between the claimed method and the applied art. The dependent claims have been amended in view of the amendment to claim 44.

Claim 1 is based on a first ply being embossed twice, in sequence, namely, a first time to generate an embossed background pattern and a second time to create a decorative motif on the same pre-embossed ply. The first embossment (background pattern) is at least partly printed with an ink applied on the protuberances of the first embossment. This results in a quite uniform coloring appearance of the web without requiring a full-surface printing. This is due to the fact that a background embossing is provided, i.e., an embossing characterized by small protuberances arranged with a high density. The same ply is then subsequently embossed to generate a decorative motif therein.

As to the primary reference, Biagiotti provides no disclosure regarding applying an ink. Rather, Biagiotti only concerns embossing and gluing of multiple plies. Biagiotti describes various embossment sequences for first

and second plies or first, second and third plies, the application of glue thereto, and lamination of the plies based on the applied glue migrating through the multiple plies. If color is desired, color is taught as being added to the glue and, thus, color is provided throughout the laminated plies the same as the glue.

The secondary reference Ruppel discloses printing a paper sheet by applying ink on protrusions generated in embossing a ply used to make the sheet. As described in Ruppel, whether two plies are joined tip-to-tip or by nesting, a first ply and a second ply are each embossed. Printing is performed on one ply and gluing is performed on the other ply. The two plies are then joined together to provide a sheet so that the print pigments are located on the inner side of the sheet between the two plies.

Thus, neither Biagiotti nor Ruppel teach or suggest combining double embossing, printing and gluing on the same ply. Further, Ruppel describes an arrangement wherein gluing and printing are performed on protrusions having substantially the same density, since (as shown in Figure 2 for example), the printed protrusions 213 are nested within the glued protrusions 405. This means that printing will result in discrete areas of inked material, interlaced with embossed/glued areas.

Applicants' claimed method, conversely, provides a background pattern obtained by background-embossing combined with inking which is further subsequently combined with an embossing to produce a decorative motif based on a series of protuberances of a greater height and lesser density than of the protuberances providing the background pattern. The embossing protuberances of the decorative motif are thus provided on a printed background. In Ruppel, the non-printed embossed pattern is joined by nesting or tip-to-tip with the printed non-glued pattern due to the two patterns both having a simple geometric distribution of protrusions. Therefore, even upon combining Biagiotti and Ruppel, applicants' claimed method would not be achieved. Clearly, such a combination of art would not result in (1) a background pattern printed embossing and a decorative glued embossing pattern on a common ply, but rather on separate plies; or (2) a background printed embossing having a different protrusion density than a glued decorative embossing, since the references each disclose printed or glued embossing protrusions having the same density.

Moreover, applicants submit that there is no suggestion in the applied art to combine Biagiotti and Ruppel. Biagiotti teaches embossing first and second webs, wherein the first web (V1, Figure 6, for example) is

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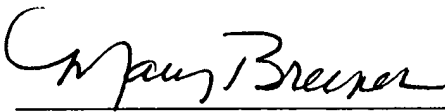
provided with glue on the protrusions thereof. Biagiotti also teaches embossing a second web V3 (embosser 305, 307). Ruppel teaches embossing a first web and applying glue to the first web and embossing and printing a second web. Based on the teachings of the two references, a combination thereof would result in printing the embossing protrusions of web V3 in Biagiotti since, following the teaching of Ruppel, glue is applied to one ply and ink is applied to the other ply. Amended claim 44 is distinct from such teaching as set forth above.

Accordingly, applicants submit that the combination of Biagiotti and Ruppel does not render the claimed method obvious within the meaning of 35 U.S.C. §103. Withdrawal of the §103 rejection is respectfully requested.

Reconsideration and allowance of the application is respectfully urged.

Respectfully submitted,

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